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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,135	06/16/2005	Yukio Tsuruoka	273944US90PCT	2266
22850 7590 11/27/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER KIM, JUNG W				
ART UNIT 2432		PAPER NUMBER		
NOTIFICATION DATE 11/27/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/539,135

Applicant(s)

TSURUOKA ET AL.

Examiner

JUNG KIM

Art Unit

2432

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. This office action is in response to the amendment filed on 9/16/09.
2. Claims 1-14 are pending.

Response to Arguments

3. As best ascertained from the English translations of the Japanese prior art, Applicant's arguments with respect to the prior art rejections have been considered and are persuasive. The two pertinent references, Maeda and Tanaka, disclose inventions for transmitting requests to update sender addresses to one or more destinations. Although it is well known to synchronize distinct databases in a manner whereby a sending node updates its database only when a successful update is made to a corresponding destination database, in the inventions of the two prior art references there is no reason for the sending node to only update its database after receiving a message from the destination node. In both Maeda and Tanaka, the inventions purport only to update sender information and not "linked information" as claimed by the applicant. "Linked information" ties a sender's address with a destination address, whereby corresponding linked information is stored at the destination side. See, for example, figures 7-12 of the instant application. Note that although Maeda discloses transmission history, which effectively identifies a "link" between the sender and the destination, and updating the transmission history when an update message is transmitted to the destination, there is no reason for the transmission history to be updated only when the destination responds, because the history reflects destination

addresses to whom the sender should send future updates. For these reasons, the prior art rejections are withdrawn.

4. For substantially the same reasons, Shaffer et al. WO 99/57859 is distinguished.

5. However, amended claims 8-14 are rejected as being directed to subject matter outside of the requirements of 101.

6. Note that claims 1-7 define an address notification device comprising a link information storage part, a link information select part, a change information registration part, a link change information sending part, and a link information change part. Pg. 44, paragraph 85 states that "Each constituent element of the address notification device 100 described above may be implemented by executing a program, which describes each operation explained above, by CPU that forms the address notification device 100." This section is interpreted such that each part defined in claims 1-7 necessitates the incorporation of hardware. I.e. each "part" is implemented by a CPU executing the program.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 8-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 8-14 define a method of address notification. However, none of these steps require a specific machine; and there is no transformation of an article or representation of an article (the method only discloses

modification of "link information") See *In re Bilski*, 2007-1130 at 15, ("At present, however, and certainly for the present case, we see no need for such a departure and reaffirm that the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101." The Court also points to the *Able* case where a dependent process claim was determined to be statutory under 101 but not the independent claim; the dependent claim was a sufficiently specific transformation because it changed "raw data into a particular visual depiction of a physical object on a display"; the transformed object must be "physical objects or substances" or "representative of physical objects or substances," *id.* at 30 and 32).

Allowable Subject Matter

Claims 1-7 are allowed for the reasons listed above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See enclosed PTO-892.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communications Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is 571-272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jung Kim/

Application/Control Number: 10/539,135

Page 6

Art Unit: 2432

Primary Examiner, AU 2432